

REMARKS

Claims 1-11 and 13-19 are pending in this application. By this Amendment, claim 19 is added. The added claim introduces no new matter. Claims 16 and 18 are canceled with prejudice to or disclaimer of the subject matter recited in these claims. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Mengistu during the November 4, 2005 personal interview. Applicants' separate record of the summary of the substance of the personal interview is included in the following remarks.

The Office Action, in paragraph 2, rejects claims 1-11 and 13-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,078,274 to Inou in view of U.S. Patent No. 6,326,723 B1 to Raj et al. (hereinafter "Raj") and JP-A-40-7-169367 (hereinafter "JP '367"). This rejection is respectfully traversed.

I. Inou Does Not Disclose a Plurality of Projections

The Office Action, at the top of page 3, states that Inou "further discloses a plurality of projections formed from the surface of at least one of a pair of transparent electrodes, the projections being formed to have a substantially periodic pitch." In support of this assertion, the Office Action alleges that element 8 in Figs. 1 and 2, and as described at col. 4, lines 42-46 of Inou, illustrates a plurality of projections. This conclusion is incorrect. As quoted in the Office Action, element 8 in at least Figs. 1 and 2 of Inou, and as described at col. 4, lines 42-46, is an antireflective film 8 provided on the transparent insulating films 2a and 2b.

There is no reasonable construction of this disclosure of Inou that can be considered to teach, or to have suggested, a plurality of projections, and specifically not the plurality of projections as are recited in independent claims 1 and 17.

Next, the Office Action indicates that Inou further discloses that the projections may be formed from the same conductive material as the transparent electrode. The Office Action indicates that Figs. 14-22, and the description at col. 2, lines 52-57, disclose such a feature. As quoted in the Office Action, the disclosure at col. 2, lines 52-57 states "in order to attain the object mentioned above, another touch panel according to the present invention has a structure in which selected portions of at least one transparent conductive film are not provided with transparent conductive film (i.e., holes) are selectively provided in the transparent conductive film." There is no reasonable construction of this disclosure of "holes" that can reasonably be considered to teach, or even to have suggested, any projection, or further, any projection being formed from the same conductive material as the transparent electrodes.

II. The Office Action Improperly Relies on Applicant's Disclosure

37 C.F.R. §1.75(a) provides "the specification must conclude with the claim particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention or discovery." As such, it is the claimed subject matter rather than the disclosed subject matter that is to be examined.

The Office Action, at the bottom of page 3 and the top of page 4, cites to Applicants' disclosure at paragraph [0043] in support of the proposition that "providing a projection made out of the same material as the transparent electrode upon the transparent electrode is functionally equivalent to providing a projection of another material on the transparent electrode and there is no disclosed criticality of having the transparent electrodes and projections be of the same material."

Claim 1 recites, among other features, wherein the projections that are provided on one of the pair of transparent electrodes face the other projections that are provided on the other of the pair of transparent electrodes, surfaces of the projections that are provided on

both of the transparent electrodes are formed from the transparent electrodes. MPEP §2143.03 provides "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In formulating the rejections under 35 U.S.C. §103(a), the Office Action cannot ignore, or otherwise read the claims in a manner to vitiate, any claim term, particularly any claim term that is clear on its face and does not require interpretation based on the Applicants' disclosure. Applicants positively recite that the surfaces of the projection are formed of the transparent electrodes. The Office Action cannot then rely on Applicants' disclosure that another structure is possible in attempting to find the subject matter recited in the claim obvious over the applied prior art references. Such an analysis uses Applicant's disclosure as a reference, but, of course, Applicants' disclosure is not prior art to Applicants' claimed invention.

In addition, it is respectfully noted that disclosure of "criticality" is not a relevant issue here, despite the Office Action's implication to the contrary.

III. Inou and Raj are Not Combinable in the Manner Suggested by the Office Action

The Office Action indicates that Inou differs from the claimed invention of the projections in that the Inou invention does not have a pitch "that is shorter than any wavelength of visible light." Raj is relied upon as disclosing such a feature, with the Office Action concluding that it would have been obvious to one of ordinary skill in the art to modify Inou by making the projections having a pitch shorter than any wavelength of visible light as disclosed in Raj. The Office Action indicates that the motivation for such a change is based on teachings disclosed in Raj that somehow the combination of Raj and Inou would result in a plurality of elements for absorbing light on the substrate, with such light absorption reducing back reflections or glare.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least independent claim 1 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references.

Further, there is no evidence that a combination of any projections taught by Raj with the antireflective film taught by Inou would result in any desired effect such as is suggested by the Office Action.

IV. JP '367 Does Not Overcome Any Shortfall in the Application of Any Combination of Inou and Raj to the Subject Matter Recited in the Pending Claims

The Office Action, on page 5, admits that Inou as modified by Raj (in the manner suggested by the Office Action) does not expressly detail that the projections are provided on both faces of the transparent electrodes. The Office Action rather indicates that JP '367, specifically some combination of elements 6, 7 and 8 of that reference, suggest providing a plurality of projections on both top and bottom part of the transparent electrodes, concluding that this will provide a transparent touch panel with improved light interference. This analysis of the Office Action fails for a number of reasons.

First, there is nothing to suggest that the alleged combination of references would lead to a transparent touch panel with improved light interference. Particularly with reference to the MPEP section quoted above, there is no specific evidence of such a motivation taught by any of the three references.

Second, even if such a feature were taught by JP '367, which Applicants do not believe that it is, as discussed below, this feature does not correspond to a feature "wherein the projections that are provided on one of the pair of transparent electrodes face the other projections that are provided on the other of the pair of transparent electrodes, surfaces of the projections that are provided on both of the pair of transparent electrodes are formed from the transparent electrodes," as is recited, among other features, in the pending claims. Element 7, as described in the Abstract, and as shown in at least Fig. 1 of JP '367, is apparently a separate and distinct element from either of the transparent electrodes 6 and/or 8.

Third, JP '367 does not clearly suggest to provide a plurality of projections on both top and bottom parts of the transparent electrodes, despite the assertions to the contrary in the Office Action. The English-language Abstract of JP '367 states that an uneven layer 5 having fine projected and recessed parts is formed uniformly on one side of one transparent substrate 4. Separately, a dotty insulating spacer 7 composed of dots is formed on the transparent electrode film 8. At least this disclosure from JP '367 specifically contradicts the conclusions made in the Office Action regarding what JP '367 may reasonably be considered to teach, or even to have suggested.

V. Conclusion

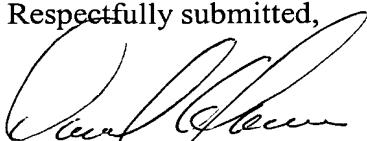
For any of the above reasons, any alleged combination of Inou, Raj and JP '367 cannot reasonably be considered to teach, or even to have suggested, the combinations of all of the features recited in at least independent claims 1 and 17. Additionally, dependent claims 2-11 and 13-15 are also neither taught, nor would they have been suggested, by any permissible combination of the applied references for at least the respective dependence of these claims directly or indirectly on independent claim 1, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 1-11, 13-15 and 17 under 35 U.S.C. §103(a) as being unpatentable over a combination of Inou, Raj and JP '367 are respectfully requested.

Applicants' representative presented the above arguments to Examiner Mengistu during the November 4 personal interview. Specifically, Applicants' representative pointed out that the applied prior art references do not teach the claimed subject matter and that they cannot be combined in the manner suggested by the Office Action. Examiner Mengistu agreed to review Applicants' arguments in more detail upon the filing of this formal response.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-11, 13-15, 17 and 19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,

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ATTACHMENT:
Request for Continued Examination

Date: November 15, 2005

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